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IN RE APPLICATION OF: SCROGGIE ET AL.

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FOR: SYSTEM AND METHOD FOR
DISTRIBUTING INFORMATION
THROUGH COOPERATIVE
COMMUNICATION NETWORK SITES

ASSISTANT COMMISSION FOR PATENTS
WASHINGTON, D.C. 20231

37 CFR 41.41 REPLY BRIEF

SIR:

In response to the paper mailed on July 12, 2005, applicants submit the following 37 CFR
41.41 reply brief.

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I. 37 CFR 41.41(a)(1) - Timeliness

This brief is in reply to the paper mailed by the USPTO and dated July 12, 2005. The paper mailed July 12, 2005 is styled as an office action. However, it is a paper reopening prosecution to a long pending appeal. In fac, the applicant's appeal to the CAFC from an adverse decision of the BPAI was remanded from the CAFC back to the examiner, because the decision of the BPAI was not deemed final. Hence, the appeal is still pending. Hence, the applicant presumes that the examiner acted in response to the appellants briefs and the remand from the BPAI instructing the examiner to determine whether to impose rejections of certain dependent claims. Pursuant to 37 CFR 41.39, an examiner is authorized to include new grounds of rejection in an examiner's answer, but an examiner is no longer authorized by the rule to withdraw an appeal. Hence, the undersigned treats the paper mailed July 12, 2005 as an examiner's answer. However, that paper at page 1 lines 6-12 specifies a 3 month period for reply and that 37 CFR 1.136(a) extensions of time apply, thereby overriding the 2 month limit in 37 CFR 41.41(a). Accordingly, this filing, with its attached extensions of time is timely.

II. 37 CFR 41.41(a)(2)

This brief includes no non- admitted amendment or evidence.

III. 37 CFR 41.41(b) and (c)

The brief is in compliance with 37 CFR 41.41(a) and therefore should be admitted. As previously noted, the paper mailed Jul 7, 2005 expressly provides for 37 CFR 1.136(a) extensions. Therefore, 37 CFR 41.41(c) is in applicable.

IV. 37 CFR 41.37 - Appeal Brief Requirements

The follow sections comply with the requirements in 37 CFR 41.37.

V. 37 CFR 41.37(a) and (b) - Timing and Fee

The notice of appeal and the fee for the notice of appeal and the appeal brief were filed a long time ago in this appeal. This filing is timely, with extensions filed herewith, for the reasons

noted in section I.

VI. 37 CFR 41.37(c) - Formalities

A. 37 CFR 41.37(c)(1)(i) - Real Party in Interest

The real party in interest is Catalina Marketing International, Inc, a Delaware corporation, which is wholly owned by Catalina Marketing Corporation, a Delaware corporation.

B. 37 CFR 41.37(c)(1)(ii) - Related Appeals and Interferences

An appeal is pending in related case attorney docket number CAT/34-SCRO-CCP; application number 09/505,632; not yet docketed at the BPAI. 09/505,632 was the subject of a prior appeal to the BPAI having BPAI docket 2002-0329. A decision in BPAI docket 2002-0329 was mailed October 27, 2003. A copy of that decision is attached as Attachment 1.

A prior decision in this appeal BPAI docket number 2004-1267 was mailed in this application on July 29, 2004. A copy of that decision is attachment 2.

A prior decision in this appeal BPAI docket number 2004-1267 on request for rehearing was mailed September 30, 2004. A copy of that decision is attachment 3.

An order in the appeal to the CAFC in this case, CAFC docket number 05-1164 remanding the case to the USPTO was issued March 9, 2005. A copy of that order is attachment 4.

C. 37 CFR 41.37(c)(1)(iii) - Status of Claims

Claims 50-89 are pending. The paper mailed July 12, 2005 rejects claims 54-59, 63-69, 73-79, and 83-89. The paper mailed July 12, 2005 erroneously fails to acknowledge the pendency of claim 50-53, 60-62, 70-72, and 80-82. There is no express rejection of those claims.

D. 37 CFR 41.37(c)(1)(iv) - Status of Amendments

All amendments are entered.

E. 37 CFR 41.37(c)(1)(v) - Summary of Claimed Subject Matter

Claim 50 defines a system for distributing product incentives to consumers over a communication network, comprising: a cooperative network site configured to store at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer (page 4 lines 2-13; Figure 2, item 36; page 9 line 29 through page 10 line 3; Figure 2, item 44); at least one of a manufacturer network site and a retailer network site coupled to said cooperative network site via said communication network (page 4 lines 20-24); and a consumer computer coupled to one of said manufacturer network site and retailer network site via said communication network (page 4 lines 27-30), wherein said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site (page 10 lines 4-16; Figure 3).

Claim 60 defines a process for distributing product incentives to consumers over a communication network, comprising: storing at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer at a cooperative network site (page 11 lines 1-7; page 10 lines 19-30; Figure 1, items 16 and 18; Figure 5, item 94; Figure 4, item 72); coupling at least one of a manufacturer network site and a retailer network site to said cooperative network site via said communication network (page 4 lines 20-25; Figure 1); coupling a consumer computer to one of said manufacturer network site and retailer network site via said communication network (page 4 lines 20-25; Figure 1); and transmitting from said cooperative network site at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site (page 10 lines 4-16; Figure 3).

Claim 70 defines a system for distributing product incentives to consumers over a communication network, comprising: means for storing at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer

incentives to purchase one of a product and a service offered by a retailer at a cooperative network site (page 11 lines 1-7; page 10 lines 17-30; Figure 1, items 16 and 18; Figure 5, item 94; Figure 4, item 72); means for coupling at least one of a manufacturer network site and a retailer network site to said cooperative network site via said communication network (page 8 lines 7-21); means for coupling a consumer computer to one of said manufacturer network site and retailer network site via said communication network (page 8 lines 7-21); and means for transmitting from said cooperative network site at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site (page 8 line 22 through page 9 line 16).

Claim 71 defines the system of claim 70, further comprising: means for storing at said cooperative network site at least one of said manufacturer incentives and retailer incentives in a data base coupled thereto (page 8 lines 18-21; Figure 1 items 16 and 18).

Claim 72 defines the system of claim 70, further comprising: means for transmitting from said cooperative network site a geographically limited list of retailers honoring incentives from said manufacturer and corresponding incentive data to said consumer via said manufacturer network site, in response to a query from said consumer made over said communication network from said manufacturer network site (page 9 lines 17-29); means for transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said manufacturer network site (page 9 line 28 through page 10 line 3); and means for transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said manufacturer network site (page 9 line 28 through page 10 line 3).

Claim 73 defines the system of claim 72, further comprising: means for transmitting from said cooperative network site said geographically limited list of retailers based on a postal code provided by said consumer to said cooperative network site via said manufacturer network site (page 9 lines 24-29).

Claim 74 defines the system of claim 70, further comprising: means for transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made

over said communication network from said retailer network site (page 10 lines 4-12); means for transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and means for transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site (page 10 lines 12-16).

Claim 75 defines the system of claim 70, further comprising: means for transmitting from said cooperative network site a consumer personal page including incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site (page 11 line 28 through page 12 line 5; means for transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and means for transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site (page 11 lines 8-27).

Claim 76 defines the system of claim 70, further comprising:

means for transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to said consumer transmitting an identification code over said communication network from said retailer network site, and basing said incentive data on consumer specific data of said consumer associated with said identification code (page 12 lines 6-20); means for transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and means for transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site (page 12 line 29 through page 13 line 3).

Claim 77 defines the system of claim 76, further comprising: means for basing said incentive data on said consumer specific data comprising a shopping history of said consumer (page 12 lines 15-20).

Claim 78 defines the system of claim 76, further comprising: means for basing said incentive data on said consumer specific data comprising demographic data of said consumer

(page 13 lines 8-19; page 14 lines 7-16).

Claim 79 defines the system of claim 76, further comprising: means for basing said incentive data on said consumer specific data comprising customer profile data of said consumer (page 14 lines 12-16).

Claim 80 defines a computer program product comprising a computer storage medium having a computer program embedded in said computer storage medium for causing a computer to distribute product incentives to consumers over a communication network, said computer program performing the steps of: storing at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer at a cooperative network site (page 4 lines 2-13; Figure 2, item 36; page 9 line 29 through page 10 line 3; Figure 2, item 44); coupling at least one of a manufacturer network site and a retailer network site to said cooperative network site via said communication network (page 4 lines 20-24); coupling a consumer computer to one of said manufacturer network site and retailer network site via said communication network (page 4 lines 27-30); and transmitting from said cooperative network site at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site (page 10 lines 4-16; Figure 3).

F. 37 CFR 41.37(c)(1)(vi) - Grounds for Rejection to Be Reviewed on Appeal

Whether the 35 USC 112, 1st paragraph rejections of claims 63-66, 73-76, and 83-86, "and all claims that depend from them" should be reversed.

Whether the BPAI should render judgement that rejections of any other one of claims 50-89 based upon Sloane and Narashimhan should be reversed.

Whether the rejections of claims 63, 73, and 83 under 103 based upon Sloane should be reversed.

Whether the rejections of claims 54, 64-69, 74-79, and 84-89 under 103 based upon Sloane (USP 5,918,211) and Narasimhan (USP 6,237,145) should be reversed.

G. 37 CFR 41.37(c)(1)(vii) - Contentions of the Appellant

I. Whether the BPAI Should Render Judgement That the 35 USC 112, 1st Paragraph Rejections of Claims 63-66, 73-76, and 83-86, "and all claims that depend from them."

The original office action appealed from rejected claims 63-66, 73-76, and 83-86, "and all claims that depend from them" under 35 USC 112, 1st paragraph. The examiner's original answer allegedly "withdrew" those rejections, which is an admission that those rejections were improper. However, the appellant is entitled to a judgement on the ground for rejection appealed, not the grounds for rejection the examiner decides to respond to in an examiner's answer. Accordingly, the appellant is entitled to a judgement reversing those 112 rejections.

II. Whether the BPAI Should Render Judgement That Rejections of Any Other One of Claims 50-89 Based upon Sloane and Narashimhan Should Be Reversed

A'. Introduction

This application is on remand from the CAFC, on remand from the BPAI, to the examiner, to determine whether to impose rejections of certain dependent claims. However, the paper mailed July 12, 2005 apparently only addresses those certain dependent claims identified as the basis for the remand. Accordingly, the appellant carries forward reasoning directed against 103 rejections of all claims based upon Sloan and Narasimhan.

B'. Prior Art Rejections over Sloane

1'. The Relevant Disclosure in this Application

This application discloses an inventive network structure and method allowing a consumer, using his or her computer (consumer communication node, summary of the invention section of the specification page 3 line 11; App. 000003.3), to contact inter alia any one of a number of different retailer web sites, to request from that web site promotions, and to receive in response a list of manufacturers offers available at the store of the retailer whose web site the consumer visited (retailer site, specification page 5 lines 17; App. 000005). Vice versa, for the consumer using his or her computer to contact a manufacturer web site to get promotions from

retailers. Specification page 5 lines 9-16. (App. 000005.)

An important feature for this appeal is that the Summary of the Invention of this specification discloses that the promotions information may be stored in a database of the cooperative network site, a site distinct from the retailer and manufacturer web sites, and that the cooperative network site's database stores information pertaining to (1) manufacturer offers to consumers and (2) retailer special deals for consumers. Specification page 4 lines 25-25; App. 000004. Most importantly, this application states that its system provides:

means at the cooperative communication node, for responding to the consumer request by providing product offer information stored in the database; and means installed at cooperating manufacturer and retailer sites, for providing communication linkage between the cooperative communication node and a consumer node logged in to one of the manufacturer or retailer sites, whereby the consumer node receives the product offer information as if logged in directly to the cooperative communication node. [Specification page 4 line 30 to page 5 line 8; App. 000004-5.]

The specification page 10 lines 4-17 (App. 000010), also refer to Fig. 3 (App. 000026), in explaining a method of use in which a consumer's computer interacts with a retailer site 12, but in which the consumer's computer's requests received at the retailer site 12 are transmitted to the SMO site 14 (the embodiment of the claimed cooperative network site), the SMO site 14 having the database pertaining to manufacturers' offers and retailers' special deals. Claim 50 corresponds to the foregoing citations to the specification, reciting the three network nodes, the "cooperative network site", the "at least one of a manufacturer network site and a retailer network site", and the "consumer computer". Moreover, claim 50 defines the database for the cooperative site explained in the specification, stating that the cooperative network site is "configured to store at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer". Furthermore, claim 50 defines the configuration of the cooperative network site that provides the function of the cooperative network site responding to a consumer request forwarded to it from a manufacturer or retailer site, by reciting "wherein said cooperative

network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site." Emphasis added. Claim 50's recitation "from one of said manufacturer network site and retailer network site" indicates that the cooperative network site is configured to respond to a consumer request transmitted to it, by sending incentive data "to said consumer", even though the cooperative network site receives the consumer request from a manufacturer or retailer network site.

2'. Claims 50-89

Claims 50-89 are limited to, and by way of example, claim 50 defines a "cooperative network site" (1) acting in response to a consumer's request, (2) defines the consumer's request being forwarded to a "cooperative network site" from a manufacturer or retailer's network (Web) site, not forwarded directly from the consumer's computer to the cooperative network site, and (3) defines the "cooperative network site" responding by transmitting ultimately to the consumer's computer, a response to that request in the form of a product incentive. The cooperative network site's response may be routed via the retailer or manufacturer's network site. In other word, the chain of transmission is from a consumer's computer, to a manufacturer or retailer computer, then to a cooperative network site, and then the cooperative network back ultimately to the consumer's computer - all in response to the consumer's request.

3'. The Relevant Disclosure in Sloane

Sloane discloses a system for influencing customer purchase decisions when the customers are deciding what to purchase. Abstract (App. 000556). Toward that end, Sloane discloses providing shoppers a wireless portable bar code scanner to scan product bar codes in a retail store. Sloane Summary of the Invention Section, column 2 line 59 to column 3 line 4. App. 000563-564. The bar code scanner can display promotions related to scanned items. Column 2 lines 19-22 and 40-45. App. 000564. Sloane discloses that the first step of Sloane's method is, referring to Figs. 3A, 3B, for the retailer or manufacturer to designate incentives for

storage in the retailer's computer system, retailer computer/controller 12. Sloane column 7 lines 4-26. App. 000566. Sloane discloses that the second step of Sloane's method is for the shopper to scan items and the retail store computer/controller 12 to respond to receipt of the item scan information by transmitting back to the scanner price and incentive information. Sloane column 7 line 49 to column 8 line 48. App. 000566.

Sloane fails to disclose acting in response to the receipt by the retailer computer/controller 12 of a request for information. Thus, Sloane fails to disclose a system analogous to the limitations in claim 50 defined by the recitation "wherein said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site." The most relevant passages in Sloane are those that clarify that the promotions information is stored, passively, on the retailer computer/controller 12 system, until such time as requested by the action of a shopper scanning a corresponding product. These passages are:

Retailer computer/controller 12 is programmed to receive and store the promotional information sent by retailer 14 or sender 16, and can therefore offer the promotions at the appropriate time and to the appropriate consumer. [Column 7 lines 22-26; App. 000566.]

Based on the received promotional product information by retailer 14 or sender 16, computer/controller 12 determines if the scanned item is a designated sale item, and if it is, sends a message to the scanner 20 which offers the consumer the discount or promotion (FIG. 7). [Column 8 lines 3-7; App. 000566.]

Both of the foregoing passages speak of the information from the retailer or sender being in existence on the retailer computer/controller 12 system prior to when that system receives a request from scanner 20 for price and promotions data. Thus, the pre-existence of the third party sender 20's promotions information resident on the retailer system is not consistent with a conclusion that Sloane discloses a system in which the third party sender 20 sends promotion information to the bar code scanner in response to the receipt by the retailer computer/controller

12 of a request for information (a scanned bar code number) from the scanner 20.

4'. Sloane does not Disclose the Concept Defined by the Claims

In contrast to what we claim, Sloane discloses a system in which only the retailer computer system responds to data sent from a bar code reader operated by the consumer by transmitting data to the consumer. Sloane third party sender 16 does not act "in response to" consumer's use of the bar code reader. Regardless of the propriety of the analogy of a bar code scanner to the claimed "consumer computer," Sloane fails to disclose the concept of consumer's request being forwarded from where it is initially received, as claimed, at a manufacturer or retailer web site, to a different network site, the claimed "cooperative network site" site, and then having that different network site act in response to the consumer's request, sending the consumer information.

5'. The Board's Position as to Claim 50's wherein clause, and "in response to" Limitation, is Supported by No Evidence

The panel of the BPAI in this appeal concludes, at decision page 6 lines 16-18, App. 000488, that, "Moreover, any promotion or discount offered in Sloane is clearly "in response to a consumer request". This sentence is the totality of the reasoning supporting the panel's conclusion that Sloane taught the "wherein said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site" limitations. In fact, when the applicant requested reconsideration, pointing out the objective evidence indicating that the panel overlooked the relevant brief (see material facts 12-14), the panel again only cited to pages 6 and 7 of its original decision. App. 000488-489.

The BPAI's panel's conclusion that "any promotion or discount offered in Sloane is clearly "in response to a consumer request" is not substantial evidence supporting a conclusion that Sloane teaches the wherein clause limitations of claim 50. It is a general conclusion unrelated to the limitations defined by the wherein clause of claim 50. Therefore, the panel's

conclusion that claim 50 is anticipated by Sloane, is a non-sequitur, unsupported by any evidence.

Generally speaking, the Board concludes that Sloane teaches a system in which the Sloane system acts "in response to" the user's request. Decision at App. 000488. Certainly, the Sloane retailer store controller 12 acts in response to bar code data received from a bar code scanner to send information back to the bar code scanner. However, the Board's general conclusion misses the conceptual point noted above in the construction of claim 50. Sloane fails to disclose a three node network system, in which the "cooperative network site is configured to transmit.... to said consumer" the manufacturer's or retailer's incentive, "in response to" a consumer request received at the retailer network site. In Sloane, the only computer responding to and sending information back to the consumer holding the bar code scanner information received from the bar code scanner, is the retailer computer/controller 12.

In Sloane, the "sender 16", does not respond to consumer requests, it merely sends the retailer computer/controller 12 promotions data for subsequent use by the retailer computer/controller 12. Thus, (1) Sloane does not disclose the sender 16 being "configured to transmit ... to said consumer" and (2) Sloane does not disclose the sender 16 being "configured to transmit in response to a consumer request ... [from the] retailer network site." Since Sloane discloses neither of those two limitations of claim 50, Sloane does not anticipate claim 50.

6'. The Board's Position as to Claim 50's wherein clause, and "in response to" Limitation, is Inconsistent With its Decision in Our Sister Case

The Board's conclusion in this case is inconsistent with its clear, well reasoned, and express conclusion in sister case 09/505,632. Specifically, on 10/27/03, the BPAI mailed a decision on a first appeal in 09/505,632. App. 000501 footnote 1 and App. 000503-513. That decision stated in pertinent part:

We agree with appellants that the subject matter of independent claims 28 and 40 is not anticipated by Sloane. ...

In Sloane, there is no middle-man communication. Incentives are communicated to the consumer by either the retailer or another sender of information, e.g., the manufacturer. *There is no transmission from the retailer website to the remote website in response to an inquiry from a consumer to the retailer website.* The examiner identifies Figure 3b of Sloane, indicating that the sender of promotion information, 16, is indicative of a "remote website."

The sender of promotion information 16 in Sloane is, indeed, sent from a remote site, e.g., the manufacturer. However, this information is communicated as an alternative to the retailer supplying incentive information. Moreover, this site 16 in Sloane, does not provide information "in response to receipt of said request at said Web site of said retailer," as required by the claims.

Accordingly, we will not sustain the rejection of claims 28 and 40 under 35 U.S.C. 102(e). [Underlining, bold, and italics added for emphasis; App. 000506 line 7 to 000508 line 11.]

7'. Sloane Does Not Disclose or Suggest Independent Claims 60, 70, and 80 for the Same Reasons Applicable to Claim 50

Each one of the independent claims 60, 70, and 80 has the same limitation defined by the wherein clause of claim 50.

Narasimhan is not alleged by the examiner or the Board to provide the 3 node interaction defined by the wherein clause and the "in response to" limitations of claim 50. Accordingly, the rejection of claim 50 is improper and should be reversed.

III'. The Newest Rejections of Claims 63, 73, and 83 Under 103 Based Upon Sloane (USP 5,918,211) Should be Reversed

Claim 63 and the claims from which it depends recite as follows:

60. A process for distributing product incentives to consumers over a communication network, comprising:

storing at least one of (i) manufacturer incentives to purchase one of a product and a

service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer *at a cooperative network site*;

coupling at least one of a manufacturer network site and a retailer network site to said cooperative network site via said communication network;

coupling a consumer computer to one of said manufacturer network site and retailer network site via said communication network; and

transmitting from said cooperative network site at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site.

62. The process of claim 60, further comprising:

transmitting from said cooperative network site a geographically limited list of retailers honoring incentives from said manufacturer and corresponding incentive data to said consumer via said manufacturer network site, in response to a query from said consumer made over said communication network from said manufacturer network site;

transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said manufacturer network site; and

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said manufacturer network site.

63. The process of claim 62, further comprising:

transmitting from said cooperative network site said geographically limited list of retailers based on a postal code provided by said consumer to said cooperative network site via said manufacturer network site.

The examiner fails to make a prima facie case for rejection of claim 63.

First, the examiner fails to show in the prior art the three entity process in which the cooperative network site acts in response to a client communication sent to the retailer or manufacturer web site, as defined by independent claim 60. Neither Sloane nor Narasimhan disclose such a concept.

In the paper mailed July 12, 2005, the examiner admits that Sloane fails to disclose a "geographically limited list of retailers based on a postal code". The examiner bases the rejection of claim 63 on the administrative notice theory that "it was old and well known in the art to have a geographical list sorted by postal code." Administrative notice is improper when it forms the basis upon which a rejection resides, and is only applicable to incontrovertible facts capable of instant and immediate confirmation. We submit that "geographically limited list of retailers based on a postal code" is not subject to administrative notice. Therefore, the examiner's rejection of claim 63 is not based upon probative evidence. Therefore, it fails to make a prima facie case. Accordingly, the rejection of claim 63 should be reversed.

Assuming arguendo that the BPAI panel finds that "it was old and well known in the art to have a geographical list sorted by postal code," the examiner still fails to make a prima facie case. This is because the examiner has not explained how the existence of a geographical list sorted by postal code would suggest (1) determining a list of retailers associated with a postal code; (2) determining a list of retailers associated with a postal code honoring a certain incentive offer; or (3) transmitting to a consumer computer a list of retailers associated with a postal code honoring a certain incentive offer.

The examiner reasons that given that "it was old and well known in the art to have a geographical list sorted by postal code," it "would have been obvious ... to sort a geographical list by postal code in order to specifically define the closest locations in which incentive data can be sent." However, the examiner assumes a fact not in evidence; that it was known to "define the closest locations in which incentive data can be." There is no teaching in Sloan or asserted by the examiner suggesting a need provide to the consumer a list of local retailers. Therefore, there is no teaching suggesting claim 63's limitation of providing a "geographically limited list of retailers based on a postal code provided by said consumer to said cooperative network site via said manufacturer network site."

The same reasoning is applicable to claim 63 applies to claims 73 and 83.

For the foregoing reasons, the BPAI panel should reverse the rejections based upon Sloane of claims 63, 73, and 83.

IV'. The Newest Rejections of Claims 54-59, 64-69, 74-79, and 84-89 under 103 Based upon Sloane (USP 5,918,211) and Narasimhan (USP 6,237,145) Should be Reversed¹

A'. Narasimhan

Narasimhan discloses a the system 100 shown in its Fig. 1 including a server 108 for transmitting marketing offers to a consumer's home computer 102. Column 3 lines 9-17 and 47-48, column 4 lines 21, and column 8 lines 35-41. Server 108 may include the web server software embodied in element 142, if the communication mode is a packet switched network, as explained by Narasimhan column 4 lines 9-16. The elements in the lower left hand side of Figure 1 (128, 130, 156, 122, 112) represent a retail store computer system. Narasimhan column 7 lines 21-31. Narasimhan's retail computer system, server 108, and home computer 102 never act in response to one another. Instead, Narasimhan teaches the consumer selecting incentives presented to his home computer by server 108. Narasimhan column 4 lines 41-49. Hence, just like Sloane, Narasimhan fails to disclose or suggest a third system (cooperative network site) acting in response to a query transmitted from the first system (consumer system) to a second system (retailer or manufacture network site), as claimed.

B'. Claims 54, 64, 74, and 84

Claim 54 and the claims it depends from read as follows:

50. A system for distributing product incentives to consumers over a communication network, comprising:

a cooperative network site configured to store at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer;

at least one of a manufacturer network site and a retailer network site

¹The USPTO paper dated July 12, 2005 contains reasoning directed to claims 55-59, despite the fact that those claims are not identified either on page 3 in the summary of the combination rejection or on the cover page of the paper.

coupled to said cooperative network site via said communication network; and
a consumer computer coupled to one of said manufacturer network site
and retailer network site via said communication network,

wherein said cooperative network site is configured to transmit at least one
of said manufacturer incentives and retailer incentives to said consumer over said
communication network, in response to a consumer request made over said
communication network from one of said manufacturer network site and retailer
network site.

54. The system of claim 50, wherein, in response to a query from said
consumer made over said communication network from said retailer network site,
said cooperative network site transmits incentive data for manufacturer offers
available at said retailer to said consumer via said retailer network site;

said consumer transmits incentive selection data selected from said
incentive data to said cooperative network site via said retailer network site; and

said cooperative network site transmits incentives corresponding to said
selection data to said consumer via said retailer network site.

In the paper dated July 7, 2005, in rejecting claims 54, 64, 74, and 84, the examiner
asserted that Sloane's combination of bar code reader/scanner interacting with Sloane's retailer
computer/controller 12 corresponds to the claimed recitation "consumer transmits incentive
selection data selected from said incentive data to said cooperative network site via said retailer
network site," relying on Sloane column 7 lines 4-13. Paper mailed July 7, 2005 page 3 lines 9-
12. If so, the examiner's correspondence is missing a claimed element because it only provide for
transmission between two nodes; the bar code reader and the computer controller. Thus, the
examiner's correspondence cannot provide distinct elements for claim 50's "consumer computer";
claim 50's "at least one of a manufacturer network site and a retailer network site"; and claim 50's
" cooperative network site". Claim 54 depends from claim 50.

In the paper mailed July 7, 2005, in rejecting claims 54, 64, 74, and 84, the examiner also
asserts that Sloane's computer/controller 12 and a stored discount or promotion corresponds to

the claimed "cooperative network site" and claimed "incentive", relying upon Sloane column 8 lines 3-7. That is, the examiner cites Sloane column 8 lines 3-7 to correspond to claim 54's recitation "said cooperative network site transmits incentives corresponding to said selection data to said consumer via said retailer network site." However, in Sloane, there is no middle man between Sloane's computer/controller 12 and the bar code scanner. Again, the examiner is missing a claimed element. Moreover, the examiner's assertions are inconsistent because it appears that the examiner is relying, first of all, on Sloane's computer/controller 12 to correspond to the claimed retailer network site, and then relying upon Sloane's computer/controller 12 to correspond to the claimed "cooperative network site". Thus, the examiner's conclusion that Sloane discloses the foregoing elements of claims 50 and 54 is incorrect.

Basically, Sloane discloses only a bar code reader and a retail store controller computer interacting with one another, and only the retail store controller computer responding to prompts from the bar code reader. Accordingly, the examiner's attempt to correspond those two elements to claim 50's 3 elements, and then to the features of dependent claim 54, fails, at least due to lack of an essential element in Sloane.

The examiner relies upon Narashimhan in support of rejections of claim 54, by stating the following.

[Narasmhan teaches] Transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site ... ([Narasimhan] Col. 8, lines 4-19, where the query is represented by the extended search for a specific type of promotion which is also defined as an extended query in Col. 8, lines 41-47.)

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to transmit incentive data in response to a query from a consumer with the motivation of giving the consumer more of a reason to

participate in the incentive program since he/she would be more likely to receive an incentive for a product in which he/she is interested. [Office action mailed July 12, 2005 page 3 lines 18 to page 4 line 7.]

However, neither Narasimhan does not disclose "transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site". Assume arguendo the examiner's correspondence of Narasimhan's server 108 to a cooperative network site and Narasimhan's home computer 102 to the claimed "consumer computer".

The examiner relies upon Narasimhan column 8 lines 4-19 and 41-47. Narasimhan column 8 lines 4-19 state in pertinent part that "the user [person operating home computer 102] can *instruct the server 108 to undertake an extended search*, including interfacing with other central servers 108." Column 8 lines 11-12. In other words, Narasimhan teaches that the user can instruct the server 108 to search for promotions for specific types of products.

Narasimhan column 8 lines 41-47 state in pertinent part that "*the user navigates through a series of menus and sub-menus 144M, 144S* to search for products/services of interest. The user may navigate based upon ... system suggestions ... in response to extended search queries from the user. Information pertaining to the user's navigation of the menus and sub-menus 144M. 144S is dynamically stored in the user profile" In other word, that passage teaches that the user, via home computer 102, navigates a menus provided by server 108, each menu displaying products for sale, and that server 108 may suggest navigation paths to the user based upon results of the users "*extended search[s]*". Those passages in Narasimhan do not disclose a system in which a cooperative network site responds, to a prompt transmitted from a consumer computer to a retailer or manufacturer network site, by delivering incentives to the consumer computer, as claimed.

The examiner asserts a combination rejection of Sloane and Narasimhan. As best understood by the appellant, the examiner asserts that Sloane's retail store computer/controller corresponds to a cooperative network site, and the examiner applies Narasimhan to suggest

modifying Sloane to provide searching other network sites for incentives. However, the claims at issue define the consumer computer transmitting a prompt to the retailer or manufacturer network site, not the cooperative network site. The examiner's correspondence fails that test because Sloane's bar code reader, which the examiner corresponds improperly to the claimed consumer computer, only transceives data with Sloane's retail store controller, which the examiner now corresponds with the claimed cooperative network site, not the claimed retailer or manufacturer network site. Moreover, neither Sloane nor Narashimhan provide any suggestion that a third site would be responsive to a prompt from a first site (consumer computer) to a second site (retailer or manufacturer network site). Thus, any combination of Sloane and Narasimhan does not suggest the subject matter defined by claim 50. Since claim 54 depends from claim 50, it, too, is non-obvious in view of Sloan and Narasimhan. Claims 54, 64, 74, and 84 all define similar limitations, and therefore the same reasoning applies to claims 64, 74, and 84.

Finally, the examiner provided no statement providing a motivation to combine. The examiner stated:

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to transmit incentive data in response to a query from a consumer with the motivation of giving the consumer more of a reason to participate in the incentive program since he/she would be more likely to receive an incentive for a product in which he/she is interested. [Paper mailed July 12, 2005 page 4 lines 3-7.]

That statement is unrelated to the examiner's prior statement corresponding to Narasimhan to claim elements. Accordingly, the examiner has not made a prima facie case, at least not one that the undersigned understands. For this additional reason, the rejections of claims 54, 64, 74, and 84 are improper and should be reversed.

C'. 54, 64-69, 74-79, and 84-89

The examiner reiterates his statements regarding Sloan for each of these claims. In addition, for claims 55, 65, 75, and 85, the examiner asserts that Narasimhan discloses a personal page; for claims 56, 66, 76, and 86, that Narasimhan discloses using an identification code; for claims 57, 67, 77, and 87, that Sloane discloses using consumer shopping history data; that for claims 58, 68, 78, and 88, that Narasimhan discloses using demographic data; and that for claims 59, 69, 79, and 89, that Narasimhan discloses using customer profile data. However, the examiner's assertions to not address the deficiencies noted above in the combined teachings of Sloane and Narasimhan; that they collectively fail to disclose a responsive three node process, a manufacturer or retailer web site, and a cooperative network site, as claimed. Therefore, the rejections of all claims are improper and should be reversed.

F. 37 CFR 41.37(c)(1)(viii) - Claims Appendix

A copy of claims 50-89 are attached as a claims appendix.

G. 37 CFR 41.37(c)(1)(ix) - Evidence Appendix

A copy of the BPAI decision in the sister case, the 3 prior decision in this case, and the order from the CAFC remanding this case to the USPTO are attached as appendices.

H. 37 CFR 41.37(c)(1)(x) - Related Proceedings Appendix

A copy of the four decisions rendered in this or related proceedings are attached.

I. 37 CFR 41.37(c)(2) - Prohibited Matter

No prohibited matter accompanies this appeal.

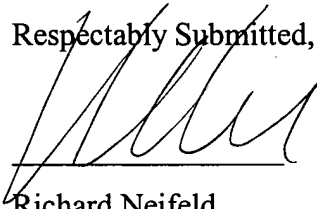
37 CFR 41.37(d) - Sanctions for failure to comply with 37 CFR 41.37

This brief complies with the rule.

12/12/05

Date

Respectably Submitted,



Richard Neifeld

Registration No: 35,299

Attorney of Record

Printed: December 12, 2005 (9:35am)

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CRO-US_051207.wpd**

VII. 37 CFR 41.37(c)(1)(viii) - Claims Appendix

50. A system for distributing product incentives to consumers over a communication network, comprising:

a cooperative network site configured to store at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer;

at least one of a manufacturer network site and a retailer network site coupled to said cooperative network site via said communication network; and

a consumer computer coupled to one of said manufacturer network site and retailer network site via said communication network,

wherein said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site.

51. The system of claim 50, wherein said cooperative network site is configured to store at least one of said manufacturer incentives and retailer incentives in a data base coupled thereto.

52. The system of claim 50, wherein, in response to a query from said consumer made over said communication network from said manufacturer network site, said cooperative network site transmits a geographically limited list of retailers honoring incentives from said manufacturer and corresponding incentive data to said consumer via said manufacturer network site;

said consumer transmits incentive selection data selected from said incentive data to said cooperative network site via said manufacturer network site; and

said cooperative network site transmits incentives corresponding to said selection data to said consumer via said manufacturer network site.

53. The system of claim 52, wherein said cooperative network site transmits said geographically limited list of retailers based on a postal code provided by said consumer to said cooperative network site via said manufacturer network site.

54. The system of claim 50, wherein, in response to a query from said consumer made

over said communication network from said retailer network site, said cooperative network site transmits incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site;

said consumer transmits incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

said cooperative network site transmits incentives corresponding to said selection data to said consumer via said retailer network site.

55. The system of claim 50, wherein, in response to a query from said consumer made over said communication network from said retailer network site, said cooperative network site transmits a consumer personal page including incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site;

said consumer transmits incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

said cooperative network site transmits incentives corresponding to said selection data to said consumer via said retailer network site.

56. The system of claim 50, wherein, in response to said consumer transmitting an identification code over said communication network from said retailer network site, said cooperative network site transmits incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, said incentive data is based on consumer specific data of said consumer associated with said identification code;

said consumer transmits incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

said cooperative network site transmits incentives corresponding to said selection data to said consumer via said retailer network site.

57. The system of claim 56, wherein said incentive data is based on said consumer specific data comprising a shopping history of said consumer.

58. The system of claim 56, wherein said incentive data is based on said consumer specific data comprising demographic data of said consumer.

59. The system of claim 56, wherein said incentive data is based on said consumer

specific data comprising customer profile data of said consumer.

60. A process for distributing product incentives to consumers over a communication network, comprising:

storing at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer at a cooperative network site;

coupling at least one of a manufacturer network site and a retailer network site to said cooperative network site via said communication network;

coupling a consumer computer to one of said manufacturer network site and retailer network site via said communication network; and

transmitting from said cooperative network site at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site.

61. The process of claim 60, further comprising:

storing at said cooperative network site at least one of said manufacturer incentives and retailer incentives in a data base coupled thereto.

62. The process of claim 60, further comprising:

transmitting from said cooperative network site a geographically limited list of retailers honoring incentives from said manufacturer and corresponding incentive data to said consumer via said manufacturer network site, in response to a query from said consumer made over said communication network from said manufacturer network site;

transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said manufacturer network site; and

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said manufacturer network site.

63. The process of claim 62, further comprising:

transmitting from said cooperative network site said geographically limited list of retailers based on a postal code provided by said consumer to said cooperative network site via

said manufacturer network site.

64. The process of claim 60, further comprising:

transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site;

transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.

65. The process of claim 60, further comprising:

transmitting from said cooperative network site a consumer personal page including incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site;

transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.

66. The process of claim 60, further comprising:

transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to said consumer transmitting an identification code over said communication network from said retailer network site, and basing said incentive data on consumer specific data of said consumer associated with said identification code;

transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.

67. The process of claim 66, further comprising:

basing said incentive data on said consumer specific data comprising a shopping history of said consumer.

68. The process of claim 66, further comprising:

basing said incentive data on said consumer specific data comprising demographic data of said consumer.

69. The process of claim 66, further comprising:

basing said incentive data on said consumer specific data comprising customer profile data of said consumer.

70. A system for distributing product incentives to consumers over a communication network, comprising:

means for storing at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer at a cooperative network site;

means for coupling at least one of a manufacturer network site and a retailer network site to said cooperative network site via said communication network;

means for coupling a consumer computer to one of said manufacturer network site and retailer network site via said communication network; and

means for transmitting from said cooperative network site at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site.

71. The system of claim 70, further comprising:

means for storing at said cooperative network site at least one of said manufacturer incentives and retailer incentives in a data base coupled thereto.

72. The system of claim 70, further comprising:

means for transmitting from said cooperative network site a geographically limited list of retailers honoring incentives from said manufacturer and corresponding incentive data to said consumer via said manufacturer network site, in response to a query from said consumer made over said communication network from said manufacturer network site;

means for transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said manufacturer network site; and

means for transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said manufacturer network site.

73. The system of claim 72, further comprising:

means for transmitting from said cooperative network site said geographically limited list of retailers based on a postal code provided by said consumer to said cooperative network site via said manufacturer network site.

74. The system of claim 70, further comprising:

means for transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site;

means for transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

means for transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.

75. The system of claim 70, further comprising:

means for transmitting from said cooperative network site a consumer personal page including incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site;

means for transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

means for transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.

76. The system of claim 70, further comprising:

means for transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to said

consumer transmitting an identification code over said communication network from said retailer network site, and basing said incentive data on consumer specific data of said consumer associated with said identification code;

means for transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

means for transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.

77. The system of claim 76, further comprising:

means for basing said incentive data on said consumer specific data comprising a shopping history of said consumer.

78. The system of claim 76, further comprising:

means for basing said incentive data on said consumer specific data comprising demographic data of said consumer.

79. The system of claim 76, further comprising:

means for basing said incentive data on said consumer specific data comprising customer profile data of said consumer.

80. A computer program product comprising a computer storage medium having a computer program embedded in said computer storage medium for causing a computer to distribute product incentives to consumers over a communication network, said computer program performing the steps of:

storing at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer at a cooperative network site;

coupling at least one of a manufacturer network site and a retailer network site to said cooperative network site via said communication network;

coupling a consumer computer to one of said manufacturer network site and retailer network site via said communication network; and

transmitting from said cooperative network site at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in

response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site.

81. The computer program product of claim 80, said computer program further performing the steps of:

storing at said cooperative network site at least one of said manufacturer incentives and retailer incentives in a data base coupled thereto.

82. The computer program product of claim 80, said computer program further performing the steps of:

transmitting from said cooperative network site a geographically limited list of retailers honoring incentives from said manufacturer and corresponding incentive data to said consumer via said manufacturer network site, in response to a query from said consumer made over said communication network from said manufacturer network site;

transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said manufacturer network site; and

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said manufacturer network site.

83. The computer program product of claim 82, said computer program further performing the steps of:

transmitting from said cooperative network site said geographically limited list of retailers based on a postal code provided by said consumer to said cooperative network site via said manufacturer network site.

84. The computer program product of claim 80, said computer program further performing the steps of:

transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site;

transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

transmitting from said cooperative network site incentives corresponding to said selection

data to said consumer via said retailer network site.

85. The computer program product of claim 80, said computer program further performing the steps of:

transmitting from said cooperative network site a consumer personal page including incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site;

transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.

86. The computer program product of claim 80, said computer program further performing the steps of:

transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to said consumer transmitting an identification code over said communication network from said retailer network site, and basing said incentive data on consumer specific data of said consumer associated with said identification code;

transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site; and

transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.

87. The computer program product of claim 86, said computer program further performing the steps of:

basing said incentive data on said consumer specific data comprising a shopping history of said consumer.

88. The computer program product of claim 86, said computer program further performing the steps of:

basing said incentive data on said consumer specific data comprising demographic data of

said consumer.

89. The computer program product of claim 86, said computer program further performing the steps of:

basing said incentive data on said consumer specific data comprising customer profile data of said consumer.

37 CFR 41.37(c)(1)(x) - Related Proceedings Appendix

Copy of BPAI decision on appeal in 09/505,632; BPAI appeal no: 2002-0329 (bates stamped pages 000503 to 000513 is Attachment 1.

Copy of BPAI decision on appeal in 08/873,974; BPAI appeal no: 2004-1267 (bates stamped pages 000483 to 000494 is Attachment 2.

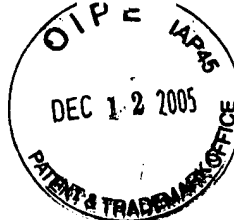
Copy of BPAI decision on rehearing in 08/873,974; BPAI appeal no: 2004-1267 (bates stamped pages 000519 to 000525 is Attachment 3.

Copy of CAFC order dated March 9, 2005 remanding 05-1164 to the USPTO is Attachment 4.

Printed: December 12, 2005 (9:35am)

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Attachment 1



11/3/03 [JointAppendix, FilesStamped_CAT-34-SCRO-US_050205.pdf]
cs

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

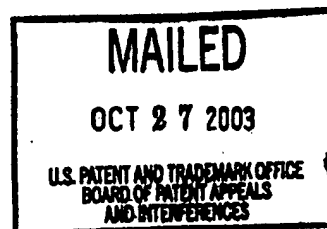
Review Date: 11/27/03

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, DAVID A. ROCHON,
DAVID W. BANKER and WILL GARDENSWARTZ

Appeal No. 2002-0329
Application No. 09/505,632

ON BRIEF



Before KRASS, JERRY SMITH and RUGGIERO, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 24-31, 34, 36-43, 46, 48 and 49.

The invention maintains a database of manufacturer offers and retailer special deals at a cooperative network site where consumers can access at least a subset of the data in the database from any manufacturer or retailer network site.

-1-

Attachment 1

APDEC-CAT34SCROCCP-031103 cs

In re SCROGGIE
Appeal No. 05-1164
000503

Appeal No. 2002-0329
Application No. 09/505,632

Accordingly, it makes little difference which site, whether manufacturer or retailer, that the consumer is logged in to when initiating the request since the data is received directly from the cooperative site. The result is that manufacturer offers and retailer special deals are exposed to many more consumers.

Representative independent claim 24 is reproduced as follows:

24. A computer network implemented method, comprising the steps of:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer;

in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

The examiner relies on the following references:

Smolen	5,915,243	Jun. 22, 1999 (filed Aug. 29, 1996)
Sloane	5,918,211	Jun. 29, 1999 (filed May 30, 1996)

Appeal No. 2002-0329
Application No. 09/505,632

Hoffman et al. (Hoffman) 6,012,039 Jan. 4, 2000
(effectively filed Aug. 29, 1996)

Claims 28, 34, 40 and 46 stand rejected under 35 U.S.C.
§ 102(e) as anticipated by Sloane.

Claims 24-27, 29-31, 36-39, 41-43, 48 and 49 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner cites Sloane and Hoffman with regard to claims 24, 25, 27, 29, 36, 37, 39, 41, 48 and 49, adding Smolen to this combination with regard to claims 26, 30, 31, 38, 42 and 43.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

Turning, initially, to the rejection under 35 U.S.C. § 102(e), an anticipatory reference is one which describes all of the elements of the claimed invention so as to have placed a person of ordinary skill in the art in possession thereof. In re Spada, 911 F.2d 205, 15 USPQ2d 1655 (Fed. Cir. 1990).

It is the examiner's position that Sloane discloses, at column 7, lines 5-10, the transmission from a consumer computer of a request for manufacturer incentives; at column 7, lines 13-

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Application No. 09/505,632

22, the transmission of region data from the website of a manufacturer in response to the request for manufacturer incentives; at column 7, lines 22-26, transmission from a remote website to the manufacturer website at least one manufacturer incentive and at least one name and address of a retailer in response to receipt of region data at the manufacturer's website; and, at column 7, lines 36-40, updating a manufacturer's incentive database.

The examiner also cites column 8, lines 3-7, of Sloane as part of the rationale for the rejection.

The examiner contends that it is inherent to include graphical image data corresponding to manufacturer incentives because Sloane does disclose that his communication line can be an online computer network or the Internet (column 7, lines 18-22) -See answer-page 4.

It is appellants' view that although Sloane does disclose processing incentives between a retailer, or product manufacturer, and a retailer computer/controller 12 over a communication network 200, Sloane does not disclose or suggest distributing product incentives to consumers over the internet (principal brief-page 7). Furthermore, argue appellants, "the communication sequence defined by the present invention is

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clearly a request-response transaction involving three distinct entities, namely, a consumer computer, a manufacturer website, and a remote website, using a request-response communication protocol" (reply brief-page 2).

We agree with appellants that the subject matter of independent claims 28 and 40 is not anticipated by Sloane. These claims clearly call for a transaction involving multiple separate entities, i.e., transmission from a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer website transmits to the consumer a list of these incentives.

In Sloane, there is no middle-man communication. Incentives are communicated to the consumer by either the retailer or another sender of information, e.g., the manufacturer. There is no transmission from a retailer website to a remote website in response to an inquiry from a consumer to the retailer website. The examiner identifies Figure 3b of Sloane, indicating that the sender of promotion information, 16, is indicative of a "remote website."

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Application No. 09/505,632

The sender of promotion information 16 in Sloane is, indeed, sent from a remote site, e.g., the manufacturer. However, this information is communicated as an alternative to the retailer supplying incentive information. Moreover, this remote site 16 in Sloane, does not provide information "in response to receipt of said request at said Web site of said retailer," as required by the claims.

Accordingly, we will not sustain the rejection of claims 28 and 40 under 35 U.S.C. § 102(e).

With regard to claims 34 and 46, these claims are a bit broader in scope. They do not recite the separate communications of claims 28 and 40. In fact, claims 34 and 46 merely require a transmission from a manufacturer to a remote Web site regarding manufacturer incentive data, and then updating the manufacturer's incentives database, including graphical image data corresponding to the manufacturer's incentives.

Sloane clearly teaches, in Figure 3b, communicating manufacturer incentive data from the manufacturer to a remote Web site. The sender of promotional information, 16, may be a manufacturer (column 7, lines 11-13) and the information is sent to the consumer, at the retail computer 12, the retail computer 12 being remote from the manufacturer.

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Application No. 09/505,632

Clearly, the information in Sloane is sent over the internet (column 7, line 22). When the manufacturer transmits this information to computer/controller 12, the information is clearly an "update" of the manufacturer's incentives database. The examiner calls this feature "inherent" and we would agree.

The only limitation of claims 34 and 46 not explicitly, or implicitly, disclosed by Sloane is "graphical image data corresponding to said manufacturers incentives." The examiner calls this a "traditional practice to present data using a graphical user interface which presents graphical image data" (answer-page 4), and holding such a disclosure in Sloane to be inherent.

Appellants' position is that Sloane does not disclose updating a manufacturers incentives database storing data defining manufacturers incentives including graphical image data corresponding to the manufacturers incentives with the manufacturer incentive data (principal brief-page 10). While it may be "traditional" to present data using a graphical user interface which presents graphical image data over the internet, "this in-and-of-itself does not teach nor suggest storing data defining manufacturers incentives including graphical image data

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corresponding to the manufacturers incentives, as in the claimed invention" (principal brief-page 10).

Since appellants do not deny that it is "traditional" to present data using a graphical user interface which presents graphical image data over the internet and Sloane clearly discloses storage of data defining manufacturers incentives by updating such information in a remote site via the internet, we will sustain the examiner's rejection under 35 U.S.C. § 102(e) since the consumer using the retailer computer/controller will be using a graphical user interface (GUI) to interface with the incentives information stored therein.

While we have sustained the rejection of claims 34 and 46 under 35 U.S.C. § 102(e), because appellants have not convinced us of error in the examiner's reasoning, it is our view that the rejection would have been stronger had it been made under 35 U.S.C. § 103 since, while not explicitly shown by Sloane, it would have been obvious for the consumer to interact with the retailer computer/controller via a GUI regarding the available manufacturers incentives. In any event, it would have been obvious to store the incentives "including graphical image data" since, as admitted by appellants, it is "traditional" to present data using a GUI.

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Application No. 09/505,632

With regard to the rejections under 35 U.S.C. § 103, we will not sustain these rejections because each of the independent claims 24, 36, 48 and 49 includes limitations similar to those in claims 28 and 40, i.e., transactions involving multiple separate entities, wherein there is transmission from a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer website transmits to the consumer a list of these incentives. As explained supra, Sloane is devoid of any such teaching. Moreover, neither Hoffman nor Smolen provides for this deficiency of Sloane. Accordingly, the examiner has not made out a prima facie case of obviousness with regard to the subject matter of claims 24-27, 29-31, 36-39, 41-43, 48 and 49 and we will not sustain the rejection of these claims under 35 U.S.C. § 103.

CONCLUSION

We have sustained the rejection of claims 34 and 46 under 35 U.S.C. § 102(e) but we have not sustained the rejection of claims 28 and 40 under 35 U.S.C. § 102(e) or the rejection of claims 24-27, 29-31, 36-39, 41-43, 48 and 49 under 35 U.S.C. § 103.

Appeal No. 2002-0329
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Accordingly, the examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

ERROL A. KRASS
Administrative Patent Judge

Jerry Smith
JERRY SMITH
Administrative Patent Judge

JOSEPH F. RUGGIERO
Administrative Patent Judge

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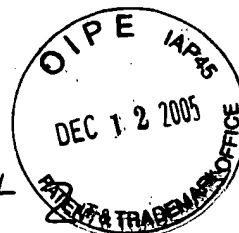
Appeal No. 2002-0329
Application No. 09/505,632

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SUITE 1001
ARLINGTON, VA 22202

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Attachment



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 51

UNITED STATES PATENT AND TRADEMARK OFFICE

Action Re Dec. on App.

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

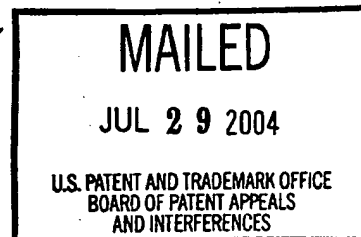
8-604

Ex parte MICHAEL C. SCROGGIE, DAVID A. ROCHON,
DAVID W. BANKER and WILL GARDENSWARTZ

Appeal No. 2004-1267 ✓
Application No. 08/873,974 ✓

CAT/34-SCRO-US

ON BRIEF



Before KRASS, FLEMING and DIXON, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the rejection of twice-rejected claims 50-89.

The invention is directed to a system, process and computer program product for distributing product incentives to consumers over a communication network.

Attachment 2

-1-

Dec App- CAT34SCROUS-040730 re SCROGGIE
Appeal No. 05-1164
000483

Appeal No. 2004-1267
Application No. 08/873,974

Representative independent claim 50 is reproduced as follows:

50. A system for distributing product incentives to consumers over a communication network, comprising:

a cooperative network site configured to store at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer;

at least one of a manufacturer network site and a retailer network site coupled to said cooperative network site via said communication network; and

a consumer computer coupled to one of said manufacturer network site and retailer network site via said communication network,

wherein said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site.

The examiner relies on the following references:

Sloane 5,918,211 Jun. 29, 1999
(filed May 30, 1996)

Narasimhan et al. (Narasimhan) 6,237,145 May 22, 2001
(filed Aug. 14, 1996)

Claims 50, 51, 60, 61, 70, 71, 80 and 81 stand rejected under 35 U.S.C. § 102(e) as anticipated by Sloane.

—
Appeal No. 2004-1267
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Claims 52-59, 62-69, 72-79 and 82-89 stand rejected under 35 U.S.C. § 103 as unpatentable over Sloane in view of Narasimhan.¹

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

At the outset, we note that while appellants devote eleven pages in the Third Supplemental Brief, filed December 23, 2002, to arguing a rejection under 35 U.S.C. § 112, first paragraph, there is no such rejection on appeal herein since the examiner has made no such rejection in the answer. Accordingly, we consider only the prior art rejections under 35 U.S.C. § 102(e) and § 103.

Independent claims 50, 60, 70 and 80 all stand rejected as being anticipated by Sloane.

Taking claim 50, as exemplary, the examiner applies Sloane as follows:

¹While claim 54 is included in the statement of rejection under 35 U.S.C. § 103, at page 5 of the answer, we note that the examiner includes this claim in the rejection under 35 U.S.C. § 102(e) in the explanation of the issues at page 2 of the answer. We will assume that the rejection of this claim is, in fact, under 35 U.S.C. § 103, as that is what the statement of rejection indicates.

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The "cooperative network site..." is said to be taught at column 7, lines 22-26, of Sloane. The "at least one of a manufacturer network site and a retailer network site coupled to said cooperative network site via said communication network" is said to be taught by Sloane at column 7, lines 13-17. The "consumer computer..." is said to be taught by Sloane at Figures 4 and 5, where the consumer computer is represented as the portable bar code scanning device. Finally, the wherein clause, "wherein said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request..." is said to be taught by Sloane at column 7, line 65 through column 8, lines 7, and at column 8, lines 44-48.

Appellants' response to this rejection appears in the Supplemental Appeal Brief, filed April 11, 2001.

Appellants argue that whereas the instant invention is directed to distributing product incentives to consumers over a communication network, including a consumer computer coupled to various network sites, Sloane is concerned with providing incentives to consumers at a point-of-purchase in a retail store.

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Application No. 08/873,974

We do not find this argument to be persuasive. Clearly, the network over which the sender, or manufacturer, sends the incentives to the retailer is a "communication" network. While even appellants admit that the processing of incentives between a retailer (or product manufacturer) and a retailer computer/controller 12 is performed over a "communication" network (see Supplemental Appeal Brief of April 11, 2001-page 8), appellants argue that Sloane fails to disclose or suggest distributing product incentives to consumers over a communication network.

Again, we are not persuaded by this argument. While appellants may envision sending the incentives directly to consumers at their home computers, in this regard, the claims require only that there is a "consumer computer" coupled to one of the retailer or manufacturer network sites and that the incentives are transmitted to the consumer over the communication network and in response to a consumer request made over the network. It is our view that Sloane clearly teaches as much. As the examiner indicates, at page 4 of the answer, the "consumer computer" in Sloane may be the hand-held scanning device which the consumer carries through the store.

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Application No. 08/873,974

First, we have already established that the transmissions in Sloane are performed over a "communication network."

Further, in Sloane, a sender of promotional information sends the information to the retailer computer/controller (column 7, lines 13-14). Thus, incentives are provided over a communication network. Then, the consumer is eventually given the promotion, or promotional price, on a given product through a wireless communication network, as the scanner (i.e., "consumer computer") offers the consumer the discount or promotion (note column 8, lines 1-7)².

While one might argue that the promotion is not transmitted directly to the consumer computer in Sloane, the promotion is clearly transmitted, at least indirectly, to the consumer, and this is all that is required by the instant claims. Moreover, any promotion or discount offered in Sloane is clearly "in response to a consumer request." Not only does Sloane indicate in the Background section that it was known for consumers to

²We note, further, the disclosure of Sloane, in the background section of the document, at column 2, lines 19-20, wherein it is disclosed that there were well known methods of issuing electronic coupons to consumers or promotions to consumers which include "consumer requested promotion/coupons through the use of their home computer and an online computer network."

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Application No. 08/873,974

request coupons over the internet, even in Sloane's actual invention, a consumer first locates and scans a related product required for a promotion and then the discount is taken (see column 8, lines 45-49).

Having determined that the examiner has set forth a prima facie case of anticipation and that appellants have failed to overcome such case by any convincing argument, we will sustain the rejection of claims 50, 51, 60, 61, 70, 71, 80 and 81 under 35 U.S.C. § 102(e).

Turning now to the rejection of claims 52-59, 62-69, 72-79 and 82-89 under 35 U.S.C. § 103, the examiner cites Narasimhan (specifically, column 4, lines 62-65, and column 8, lines 4-13) as providing for the deficiency, in Sloane, of disclosing, as in claim 52, for example, "wherein, in response to a query from said consumer made over said communication network from said manufacturer network site, said cooperative network site transmits a geographically limited list of retailers honoring incentives from said manufacturer and corresponding incentive data to said consumer...."

It is the examiner's position that it would have been obvious to provide such a list of geographically limited retailers so as to give the consumer "the ability to customize

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and control his or her purchase preferences by location" (answer-page 5).

Appellants' Supplemental Appeal Brief, filed April 11, 2001, says nothing about this rejection based on Narasimhan, referring only to a rejection based on a patent to Allsop, together with Sloane. Similarly, neither appellants' Appeal Brief, filed March 2, 2001, nor the Third Supplemental Brief, filed December 23, 2002, says anything about this rejection. Accordingly, nothing therein is persuasive of any error on the examiner's part in rejecting the claims under 35 U.S.C. § 103 over Sloane and Narasimhan.

In fact, we have nothing responsive to the examiner's specific rejection under 35 U.S.C. § 103 until the Reply Brief, filed April 22, 2003, at which point appellants present no argument regarding the merits of the examiner's rejection, preferring, instead, to attack the examiner's rejection under 35 U.S.C. § 103, based on the combination of Sloane and Narasimhan, by attacking it procedurally. More particularly, appellants argue that this constitutes a new ground of rejection which is prohibited by 37 CFR 1.193 (a) (2).

We have reviewed the record of this case and it appears that the rejection under 35 U.S.C. § 103, based on Sloane and

Appeal No. 2004-1267
Application No. 08/873,974

Narasimhan, is not a new ground of rejection as to claims 52, 53, 55-59, 62, 72 and 82, the rejection in the Answer appearing substantially the same as a rejection of those claims in Paper No. 45 (page 9), mailed September 23, 2002.

However, the rejection of claims 54, 63-69, 73-79 and 83-89 under 35 U.S.C. § 103, appearing in the answer, does constitute a new ground of rejection because the rejection of these claims on this ground does not appear in Paper No. 45.

Accordingly, we will summarily sustain the rejection of claims 52, 53, 55-59, 62, 72 and 82 under 35 U.S.C. § 103 because the examiner seems to have stated a reasonable case for a finding of obviousness, which has not been rebutted by appellants in any substantive manner. We note, however, that our affirmance of this rejection is pro forma, and not based on substantive arguments since appellants have presented no substantive arguments with regard to this rejection.

With regard to the rejection of claims 54, 63-69, 73-79 and 83-89 under 35 U.S.C. § 103, this is a new ground of rejection, not permitted under 37 CFR 1.193 (a)(2). Accordingly, with regard to the rejection of these claims, we remand the application to the examiner to either withdraw the rejection or reopen prosecution, giving appellants an opportunity to respond

Appeal No. 2004-1267
Application No. 08/873,974

to the new ground of rejection if it is to be applied.

Since we have sustained the rejection of claims 50, 51, 60, 61, 70, 71, 80 and 81 under 35 U.S.C. § 102(e) and the rejection of claims 52, 53, 55-59, 62, 72, and 82 under 35 U.S.C. § 103, the examiner's decision is affirmed.

The application is also remanded to the examiner for action consistent with the reasoning herein with regard to the rejection of claims 54, 63-69, 73-79 and 83-89 under 35 U.S.C. § 103.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

Appeal No. 2004-1267
Application No. 08/873,974

This application, by virtue of its "Special" status, requires an immediate action, MPEP 708.01 (8th ed., August, 2001).

AFFIRMED AND REMANDED

Encl. 11

ERROL A. KRASS
Administrative Patent Judge

Michael R. Fleming
MICHAEL R. FLEMING

MICHAEL R. FLEMING
Administrative Patent Judge

Joseph L. DeF...

JOSEPH L. DIXON
Administrative Patent Judge

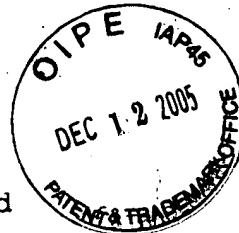
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Appeal No. 2004-1267
Application No. 08/873,974

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2001 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

Attachment 3



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 53

UNITED STATES PATENT AND TRADEMARK OFFICE

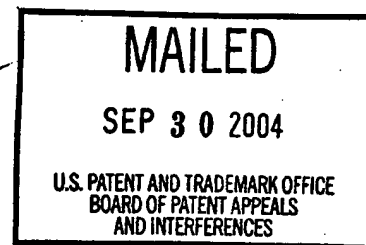
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BEFORE THE BOARD OF PATENT APPEALS
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Ex parte MICHAEL C. SCROGGIE, DAVID A. ROCHON,
DAVID W. BANKER and WILL GARDENSWARTZ

Appeal No. 2004-1267 ✓
Application No. 08/873,974 ✓

ON BRIEF



Before KRASS, FLEMING and DIXON, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request rehearing of our decision of July 29, 2004, wherein we affirmed the examiner's decision rejecting claims 52, 53, 55-59, 62, 72 and 82 under 35 U.S.C. § 103.

Initially, appellants argue that we have not decided an issue involving a rejection under 35 U.S.C. § 112, even though that rejection had been withdrawn by the examiner and was not on

—
Appeal No. 2004-1267
Application No. 08/873,974

appeal before us. Appellants take the position that the rejection was, in fact, on appeal because they had appealed from the examiner's rejection of the claims under 35 U.S.C. § 112 and that we must decide the propriety of this rejection even in the face of the examiner's withdrawal of such rejection.

We disagree. Once an examiner withdraws a rejection of claims, at or before the time of the answer, that rejection is no longer before us on appeal and we will not issue an opinion as to the propriety of a now-theoretical rejection.

Appellants are concerned that since there was a suggestion of reopening prosecution in our decision¹, a lack of a decision by us regarding the § 112 rejection might leave appellants open to re-imposition of that rejection by the examiner.

If, and when, the examiner deems it appropriate to make a rejection under 35 U.S.C. § 112, and such rejection is appealed to us, we will treat that rejection. But, at least at the time of the answer, the examiner no longer believed a rejection under 35 U.S.C. § 112 to be proper and chose not to make it. The Board would find itself in an awkward position attempting to decide an

¹We indicated in the decision, at page 9, that the examiner's rejection of claims 54, 63-69, 73-79, and 83-89 under 35 U.S.C. § 103 was a new ground of rejection, not permitted under 37 CFR 1.193 (a) (2), and remanded to the examiner to either withdraw the rejection or reopen prosecution.

—
Appeal No. 2004-1267
Application No. 08/873,974

issue on which both appellants and the examiner are in apparent agreement, viz., that a rejection under 35 U.S.C. § 112 was not improper. Where there is no controversy, there is no need for the Board, or any tribunal, to make a decision.

Accordingly, we decline appellants' invitation to render a decision on whether claims are proper, within the meaning of 35 U.S.C. § 112.

Appellants further argue that we misapprehended the claim limitation, "in response to a consumer request..." and the reasoning in support thereof in the brief filed July 10, 2001.

Part of the problem arises from multiple filings, by appellants, of various briefs and supplemental briefs, and attempting to incorporate by reference, into the arguments, all of these briefs. Thus, rather than including all of appellants' arguments in a single brief and/or a brief and possibly one reply brief, the record is rife with arguments scattered throughout several papers.

In any event, our decision did treat the "in response to a consumer request..." limitation of the claims, by indicating, at page 6 of our decision, that any promotion or discount offered in Sloane is clearly "in response to a consumer request." The reason is explained in the paragraph bridging pages 6-7 of the

Appeal No. 2004-1267
Application No. 08/873,974

decision. Thereat, we indicated that the background section of Sloane disclosed that it was known for consumers to request coupons over the internet (see column 2, lines 18-21). Further, we noted, at page 7 of the decision, that even in Sloane's actual invention, a consumer first locates and scans a related product required for a promotion (see column 8, lines 45-49). Accordingly, it is clear that any promotion, or discount, issued is "in response to a consumer request..." as claimed.

Thus, it is clear that, contrary to appellants' assertions, we did not ignore the "in response to a consumer request..." limitation of the claims.

Appellants further argue that we overlooked the brief filed July 10, 2001 and the reasoning therein relative to the inapplicability of the Narasimhan reference. We have reviewed the second supplemental brief, filed July 10, 2001, but find nothing therein to cause us to modify our decision. In that document, appellants simply point out that "there is no evidence supporting the examiner's rationale that transmitting a geographically limited list of retailers honoring incentives in response to a query is a more efficient way of obtaining desired information;" and that the examiner's conclusion of obviousness in combining the teachings of Narasimhan and Sloane "is vague" and "unsupported" by any evidence.

Appeal No. 2004-1267
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We find appellants' arguments insufficient to overcome the examiner's reasonable explanation that Narasimhan suggests, at column 4, lines 62-65, and column 8, lines 4-13, providing for certain geographic-specific promotions to consumers. Again, appellants do not appear to have addressed the specific teachings of Narasimhan, as pointed out by the examiner. Appellants' mere assertion that there is no evidence supporting the examiner's rationale, or that the examiner's conclusions are "vague," fails to point out the error in the examiner's position that Narasimhan clearly suggests using geographic-specific promotions.


Having responded to each and every assertion made by appellants in the Request for Rehearing, filed August 6, 2004, and finding nothing persuasive therein, we decline to make any modification to our decision of July 29, 2004. Appellants' request for rehearing is granted to the extent that we have reviewed and reconsidered our decision and the evidence of record, but the request is denied with respect to making any changes therein.


Appeal No. 2004-1267
Application No. 08/873,974

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED


ERROL A. KRASS
Administrative Patent Judge


MICHAEL R. FLEMING
Administrative Patent Judge


JOSEPH L. DIXON
Administrative Patent Judge

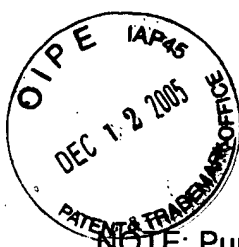
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Appeal No. 2004-1267
Application No. 08/873,974

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Attachment 4

NOTE: Pursuant to Fed. Cir. R. 47.6, this order
is not citable as precedent. It is a public order.

United States Court of Appeals for the Federal Circuit

05-1164 ✓
(Serial No. 08/873,974) ✓

IN RE MICHAEL C. SCROGGIE, DAVID A. ROCHON, DAVID W. BANKER,
and WILL GARDENSWARTZ (Real Party in Interest Catalina Marketing Corporation)

ON MOTION

ORDER

Upon consideration of the unopposed motion of Michael C. Scroggie et al. to
remand this case to the Patent and Trademark Office for further proceedings,

IT IS ORDERED THAT:

- (1) The motion is granted.
- (2) Each side shall bear its own costs.

FOR THE COURT

MAR - 9 2005

Date

Jan Horbaly
Clerk

cc: Robert G. Crockett, Esq.
John M. Whealan, Esq.

s5

MAR - 9 2005

ISSUED AS A MANDATE : _____

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

MAR - 9 2005

JAN HORBALY
CLERK

Attachment 4

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Ord - CAT34SCROUS - 050311

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